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In re Application of :  
SMITH et al : DECISION ON  
Application No.: 08/392,934 :  
PCT No.: PCT/US93/08699 : PETITION  
International Filing Date: 15 September 1993 :  
Priority Date: 15 September 1992 : UNDER 37 C.F.R. 1.48(a)  
For: IMMUNOREACTIVE PEPTIDES :  
FROM EPSTEIN-BARR VIRUS :

This decision is in response to applicants' "AMENDMENT AND PETITION TO CORRECT INVENTORSHIP UNDER 37 CFR § 1.48(a) TO ADD INVENTORS NOT ORIGINALLY NAMED IN THE APPLICATION", filed on 26 December 1995.

BACKGROUND

On 15 September 1993, applicants filed international application, PCT/US93/08699 claiming priority of an earlier filed U.S. application 07/945,280 filed 15 September 1992. A Demand for international preliminary examination, in which the United States was elected was filed 08 April 1994. Accordingly, the thirty month time period for paying the basic national fee and providing a copy of the International Application, in accordance with 37 C.F.R. 1.495(b), expired midnight on 15 March 1995.

On 02 March 1995, applicants filed papers entering the national stage in the United States Patent and Trademark Office (PTO) including *inter alia*, a transmittal letter, the basic national fee; and a copy of the international application.

On 29 August 1995, the PTO mailed applicants "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (form PCT/DO/EO/905) ('905), indicating that an oath or declaration in compliance with 37 CFR 1.63 was required.

On 26 December 1995, applicants filed the above captioned "AMENDMENT AND PETITION TO CORRECT INVENTORSHIP..." requesting that a previously unnamed co-inventor, Susan Pothen Varghese, be added as co-inventor in the above application.

### DISCUSSION

A petition under 37 CFR 1.48(a) must be accompanied by (1) a statement of facts verified by the original named inventor(s) establishing when the error without deceptive intent was discovered and how it occurred; (2) an oath or declaration by each of the actual inventors as required by 37 CFR 1.63; (3) the fee set forth in 37 CFR 1.17(h); and (4) the written consent of any assignee. Applicants' petition satisfies item (3).

Regarding item (1) above, there is no indication when in 1994 Dr. Varghese completed her Ph.D. dissertation, and Gary Peterson became concerned that Ms. Varghese might have made certain contributions to the invention. Also, when was it actually concluded that she was an inventor?

Regarding item (2) above, the declaration executed by Richard Smith, Gary Pearson, D. Parks and Susan Varghese is not in compliance with 37 CFR 1.63, in that, it fails to identify the prior U.S. application having a filing date before that of the application of which the present application is a CIP (37 CFR 1.63(d)).

Regarding item (4) above, ownership is established by submitting to the Office documentary evidence of a chain of title from the original owner to the assignee, or by specifying (e.g. reel and frame number) where such evidence is recorded in the Office. In addition to establishment of ownership, there is a further requirement that the assignee submit a statement specifying that the evidentiary documents have been reviewed and certifying that to the best of the assignee knowledge and belief, title is in the assignee seeking to take action. No such evidence or statements have been submitted.

Additionally, the "ASSENT OF ASSIGNEE TO ADDITION TO ORIGINALLY NAMED INVENTORS" is defective, in that, James Burris MD., Associate Dean Research Operations, does not have apparent authority to sign on behalf of the assignee. Under these conditions, M.P.E.P. 324 states in part; The statement may be signed by any person, if the statement includes an averment that the person is empowered to sign on behalf of the assignee. No such averment has been made.

### CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.48(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(a)".

Extensions of time are AVAILABLE under 37 CFR 1.136(a).

Please address future correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and direct the contents of the letter to the attention of the PCT Legal Office.

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